

REMARKS

STATUS OF THE CLAIMS

Claims 16-40 are pending. No claim amendments have been made.

INFORMATION DISCLOSURE STATEMENT

Applicant filed an Information Disclosure Statement with PTO-Form 1449 on February 18, 2000. The Examiner has indicated that no Information Disclosure Statement is in the Patent Office file. Attached hereto is a copy of the Information Disclosure Statement, PTO- Form 1449, and references cited therein as originally filed on February 18, 2000. As further evidence that such documents were actually filed on February 18, 2000, also attached hereto is the stamped postcard listing the above items. Applicant respectfully requests the Examiner to consider the references filed on February 18, 2000, and to initial and return to the undersigned the PTO-Form 1449. Also, Applicant notes that the Examiner's statements about the "Information Disclosure Statement filed on May 7, 2001," not complying with 37 C.F.R. §1.97(c) are irrelevant because Applicant did not file an Information Disclosure Statement on May 7, 2001. What was submitted was merely a copy of the PTO-1449 already filed on February 18, 2000.

REJECTION UNDER 35 U.S.C. §103(A)

The Examiner rejects claims 16-40 under 35 U.S.C. §103(a) over WO 97/49378 (Terranova). Applicant traverses the rejection for the reasons already of record as well as those presented below.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

To establish a *prima facie* case of obviousness, an Examiner must show some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify reference teachings. Also, there must be a reasonable expectation of success in making the modification. M.P.E.P. § 2143 (7th ed. 1998). Applicant respectfully submits that the Examiner has failed to establish the suggestion or motivation that would lead one of ordinary skill in the art to make the claimed invention with a reasonable expectation of success.

A. The Examiner Has Failed to Establish the Requisite Motivation for
Selecting the Claimed At Least One Second Oxidation Base

Terranova teaches an oxidation dyeing composition comprising at least one specific pyrazolo [1,5-a] pyrimidine derivative as an oxidation base. (Abstract.) Terranova teaches that his composition can also contain at least one additional oxidation base. (Page 9, lines 24-25.) The Examiner appears to be relying on this teaching as the basis for the requisite motivation to select the specifically claimed at least one second oxidation base for use in Terranova's composition. Applicant submits that such the broad teachings of Terranova are not sufficient to have motivated one of ordinary skill in the art to select N,N-bis(β -hydroxyethyl)-paraphenylenediamine or its acid addition salts as the additional oxidation base of Terranova.

In particular, Terranova provides an initial list of classes of suitable additional oxidation bases. (Page 9, line 24 to page 10, line 2.) The initial class list is then expanded to a laundry list for each class of suitable additional oxidation bases. (Page 10, line 4 to page 11, line 5.) This disclosure provides a lot of information to one of ordinary skill in the art. However, this disclosure, while it does include Applicant's claimed second oxidation base, N,N-bis(β -hydroxyethyl)-paraphenylenediamine, does

not provide any teaching or suggestion on how one of ordinary skill in the art should select an additional oxidation base from all the possible oxidation bases. As admitted by the Examiner, "Terranova does not exemplify a composition which contains or uses the claimed second oxidation base." (Office Action dated December 7, 2000, at 3.) In fact, there is not a single example of a composition comprising an additional oxidation base. As a result, one of ordinary skill in the art is not even given a starting point as to how to choose an additional oxidation base let alone any direction that would lead him/her to choose Applicant's very specific second oxidation base.

Absent such guidance, one of ordinary skill in the art would be left to select and test one oxidation base at a time. At most, the teachings in Terranova would make it obvious to try combining its disclosed oxidation base with various additional oxidation bases. However, as the Examiner knows, obvious to try is not the correct standard.

Further, because there is no guidance in Terranova as to which second oxidation base to select, one of ordinary skill in the art is left to rely on his own personal knowledge for the requisite motivation to select a suitable additional oxidation base. As disclosed by Terranova, oxidation dyes must "satisfy a certain number of requirements." The dye must "have no toxicological drawbacks, it must be able to give shades of the desired intensity, and it must be able to withstand external agents (light, bad weather, washing, permanent waving, perspiration, rubbing). . . must also be as unselective as possible . . . [and] have good chemical stability." (Page 2, lines 1-14.) The person of ordinary skill in the art is given no direction as to how to choose a second oxidation base for inclusion in Terranova so that all of these "requirements" are met.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Terranova also appears to teach that the selection of the oxidation base has an effect on the resulting properties of the composition, such as color degradation. For example, Examples 25 and 26 demonstrate that two compositions comprising the same coupler, but different oxidation bases, results in differences in color degradation. (Pages 38-41.) These data suggest that one oxidation base can have an effect on the resulting properties of the hair dye. This would lead one of ordinary skill in the art to believe that the inclusion of an additional oxidation base into a composition would also affect the resulting properties, such as color degradation, of the hair dyes. The data do not demonstrate whether the effect would be for the better or for the worse. In fact, the data do not demonstrate any predictability as to which oxidation bases have better or worse effects. Because one of ordinary skill in the art would not be able, based on Terranova's disclosure, to predict whether the inclusion of an additional oxidation base in the composition of Terranova would advantageously affect the dye properties or not (e.g., lead to improved color degradation or poor color degradation), the selection of the claimed at least one second oxidation base would not have been obvious from the reference teachings or from the knowledge available to one of ordinary skill. Obviousness requires some degree of predictability. M.P.E.P. § 2143.02.

For at least these reasons, the Examiner's reliance on Terranova is improper. A reading of the reference as a whole supports Applicant's position that the general teachings of including an additional oxidation base are too broad to motivate one of ordinary skill in the art to select the specifically claimed at least one second oxidation base. Applicant also submits that Terranova, as one of ordinary skill in the art, teaches that the inclusion of different oxidation bases in a composition results in different effects

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

on the ultimate properties of the composition that can not be predicted with any reasonable expectation of success. (See discussion below in section C.)

B. The Examiner Has Failed to Establish the Requisite Motivation for Selecting the Claimed At Least One Coupler Chosen from Meta-Phenylenediamines and Meta-Aminophenols

Terranova teaches that the compositions may also contain a coupler in order to modify the shades or enrich them with glints. (page 11, lines 12-14.) The couplers include both m-aminophenols and m-phenylenediamine. (Page 11, lines 6-21.) The Examiner appears to be relying on this teaching as the basis for the requisite motivation to select the claimed at least one coupler chosen from meta-phenylenediamines and meta-aminophenols of formula (I) for use in Terranova's composition. Applicant submits that the a broad teachings of Terranova are not sufficient to have motivated one of ordinary skill in the art to select the claimed at least one coupler as the coupler to be used in Terranova.

In particular, Terranova provides an initial list of classes of suitable couplers. (Page 11, lines 16-21.) The initial class list is then expanded to a laundry list. (Page 11, lines 23-30.) This is a lot of information. Indeed, Terranova appears to be suggesting that almost any coupler may be used in his composition. However, this disclosure, while it does include Applicant's claimed at least one coupler, does not provide any teaching or suggestion on how one of ordinary skill in the art should select at least one coupler from all the disclosed couplers, or even from the disclosed classes of couplers. Absent such guidance, one of ordinary skill in the art would be left to select and test one coupler at a time. As most, the teachings in Terranova would make it obvious to try combining its disclosed oxidation base with various couplers. However, as the Examiner knows, obvious to try is not the correct standard.

The Examiner states that "Terranova teaches that it is known in the hair dyeing art to mix oxidation bases and couplers in order to obtain a wide range of colors." (Office Action dated December 7, 2000, at 3.) While this is true, color is not the only variable that must be considered in formulating an oxidation dye composition. Specifically, Terranova teaches that dyes must "satisfy a certain number of requirements." (Page 2, lines 1-14.) So although, color and its intensity are relevant variables, they would not be the only factors at issue in formulating an oxidative dye composition. In fact, Terranova appears to focus on improved color degradation as requirement for its compositions.

Specifically, Terranova teaches that the color degradation of a composition after shampooing varies depending on the combination of an oxidation base and coupler. This is best exemplified when the oxidation base remains the same, but the coupler varies. For example, Examples 25, 27, 29, and 31 each used the disclosed oxidation base, pyrazolo[1,5-a]pyrimidine-3,7-diamine dihydrochloride, but in combination with different couplers, such as, for example, resorcinol and 2-methyl-5-aminophenol. Each of these compositions had a different value of color degradation. (See Table on page 41.) In fact, none of the compositions in Examples 25-32 exhibited the same color degradation after shampooing. These data teach that the resulting properties, such as color degradation, of a particular composition comprising a combination of an oxidation base and a coupler are unpredictable. That is, some combinations have better results than others.

This would lead one of ordinary skill in the art to believe that the inclusion of a coupler into a composition would not only affect the color shade, but would also affect

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

the resulting properties, such as color degradation, of the hair dyes. The data do not demonstrate whether the effect would be for the better or for the worse. In fact, the data do not demonstrate any predictability as to which couplers have better or worse effects. Because one of ordinary skill in the art would not be able to predict whether the inclusion of a coupler in the composition of Terranova would lead to improved properties (e.g., improved color degradation), the selection of a coupler falling within the scope of Applicant's claims would not have been obvious. As noted above, obviousness requires some degree of predictability. M.P.E.P. § 2143.02.

C. The Examiner has Failed to Establish that a Reasonable Expectation of Success Exists

The Examiner states that because "the reference teaches all of the claim limitations, there is no need for motivation to modify the reference, and [that] applicant expects success using the composition as claimed because he teaches the inclusion of all of the elements as claimed." (Office Action dated July 12, 2001, at 5.) Applicant respectfully submits that the teachings of Terranova are too broad to have motivated one of ordinary skill in the art to make the claimed invention with any reasonable expectation of success.

The Examiner relies on Terranova's broad teachings of optionally including an additional oxidation base and a coupler with its disclosed oxidation base to support her statement that Terranova teaches making the claimed invention. Applicant disagrees with the Examiner's position. As noted above, Terranova teaches that oxidation dyes must satisfy a certain number of requirements. Terranova also teaches that the use of its disclosed oxidation base results in a dye composition possessing these

requirements. (Page 2, line 26 to page 3, line 3.) However, as discussed, there are no data showing the effects of including an additional oxidation base on properties such as the color degradation of the dye after shampooing. Moreover, there are no data showing the effects of selecting Applicant's specifically claimed first and second oxidation bases, and coupler. Because there are no data for such a composition, it can not be extrapolated that such a composition would meet the requirements disclosed by Terranova. The data that are available demonstrate that the choice of oxidation base affects color degradation. See Examples 25 and 26. The data also demonstrate that the coupler affects color degradation. See Examples 25 and 27. Thus, the data do not support a position that there is a reasonable expectation of success.

D. *In re Kerkhoven*

The Examiner argues that "[i]t is *prima facie* obvious to combine two compositions each taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose" (Office Action dated July 12, 2001, at 6) (citing *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980)). Even though Applicant is unsure which two "compositions" the Examiner had in mind, Applicant submits that reliance on *Kerkhoven* to establish a *prima facie* case of obviousness here is improper, because the holding and reasoning of *Kerkhoven* do not apply to this case. In *Kerkhoven*, the applicant claimed a process for preparing a detergent composition comprising mixing two known detergent materials. The court reasoned that "the idea of combining [the two detergent materials] flows logically from their having been individually taught [each for the very same purpose, *i.e.*, as detergents] in the prior art." 205 U.S.P.Q. 1069, 1072. Based on this reasoning, the

court held that the claims at issue requiring “*no more than the mixing together*” of two conventional detergents to make a third detergent composition set forth “*prima facie* obvious subject matter.” *Id.* (emphasis added).

The present invention, however, does not fall within the facts of *Kerkhoven* because the present invention does not involve merely mixing two dyeing compositions. First, the presently claimed composition is a combination of three ingredients, and not two, as discussed by *Kerkhoven*. Second, as discussed at length above, the Office is picking and choosing these ingredients from different parts of the reference in an attempt to obtain the presently claimed invention. One of ordinary skill in the art, unless relying on hindsight, would not have had any reason or guidance to make these very specific selections. This picking and choosing hardly qualifies as “mere mixing.” Third, while the *Kerkhoven* involved the mere mixture of two detergents, the oxidation dye composition of the present invention involves an oxidative reaction, again hardly a “mere mixture.” See, e.g., *The Science of Hair Care*, Ed. Charles Zviak, Marcel Dekker, Inc. New York (1986) 235-286.

For at least the foregoing reasons, the Office has failed to establish a *prima facie* case of obviousness. Applicant requests reconsideration and withdrawal of the rejection.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 4, 2002

By: Carol L. Cole
Carol L. Cole
Reg. No. 43,555

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com